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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,301	04/23/2001	Irah H. Donner	114953.402US2	5047
24504 7590 03/22/2007 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			EXAMINER POINVIL, FRANTZY	
			ART UNIT	PAPER NUMBER
			3692	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/839,301

Applicant(s)

DONNER, IRAH H.

Examiner

Frantzy Poinvil

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed 1/5/2007 have been fully considered but they are not persuasive.
- 2.

Response to the Arguments:

Applicant argues that Pakes is not relevant because Pakes does not value intellectual properties but merely determines whether maintenance fees should be paid for the intellectual property based on finding additional uses of the patents.

In response, the Examiner disagrees. The title of the section being used as teachings from Pakes is entitled "Patents as options: Some estimates of the value of holding European patent stocks". Here, even the title itself discloses or suggests estimating the value of patents. The Examiner does acknowledge that Pakes determines whether a maintenance fee should be paid. In so doing, Pakes determines the current value of the patent and whether the patent would provide future returns. The applicant is directed to pages 764 and 776 of Pakes where it is disclosed in determining whether to hold a patent, the current value of the patent must be assessed.

Applicant then argues that the Examiner has failed to show any reasonable expectation of success and that Pakes does not relate to determining the value of intellectual property portfolio.

In response, on Page 764, Pakes states “ Equation (7) and the explanation which follows it, describes the Markov process assumed to generate the return from holding a patent”. On page 776, it is provided a table that illustrates uses of patents for increasing the returns of patents.

Regarding the Hough reference, applicant argues that Hough does not disclose “objectively determinable values forming a baseline”.

In response, the Examiner disagrees because Hough takes into account a given property and obtains the values of similar properties in a neighborhood (thus serving as a baseline) for comparison with a subject property.

Applicant then argues that Hough fails to disclose a baseline.

In response, the Examiner disagrees as the baseline is regarded as the similar properties having different rooms, features and options available in the properties.

The Examiner had stated that the type of data does not provide patentable differences when viewing the system of Hough. Applicant then argues that the specific data as claimed in their invention provides the estimated intellectual property value and/or worth of the present invention.

In response, it is noted that the method and system perform similarly as the applicant’s claimed invention with the only difference being the type of data being processed. As such, the Examiner had stated that since the means and steps found in Hough are similar to that of the

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claimed invention in determining the value of a real estate property. Introducing different types of data for performing the same steps or function would not provide patentable differences as the result would only apply to the type of associated data. Thus, one of ordinary skill in the art desiring to objectively determine the value of intellectual property portfolio would have turned to the teachings of Pakes in order to provide the proper variables related to a patent or patent applications for incorporating such in the method and system of Hough. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Pakes into Hough in order to determine the value of an intellectual property portfolio.

Applicant then states that all claim limitations must be provided patentable weight and argues that the Examiner has not applied patentable weight to the all the claimed limitations.

In response, the Examiner disagrees. The Examiner had stated that the type of data does not matter and provided reasons. Furthermore, the Examined had introduced the teachings of Pakes for associating the type of data with intellectual properties.

Applicant then argues that the prior art teaches away from the Examiner's proposed combination.

In response, the Examiner disagrees. Hough is directed to a system and method for determining the value of real estate properties. Pakes has been applied to denote teachings of different variables and factors used in determining the value of intellectual properties. Thus, the proposed combination does not teach away from the claimed invention.

Applicant then argues that the claimed invention recites patentable subject matter over the Examiner's proposed combination.

In response, the applicant is directed to the prior Office action.

3. The prior rejection is repeated below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hough (US Patent No. 5,414,621) considered with Ariel Pakes, "Patents as options: Some estimates of the value of holding European patent stocks", *Econometrica*, Vol. 54 (July 1986), pages 775-784.

As per claims 15, 21, 28, 34, 41, 42, 43, 48 and 55, Hough discloses a system and method for determining the value of a real estate property. See the abstract. The system and method comprise:

Storing first objectively determinable characteristics of representative of real estate properties and objectively determinable values corresponding to each of the representative real

estate properties, the first objectively determinable characteristics and the objectively determinable values forming a baseline against which to assess the estimated value of the real estate subject (column 4, lines 7-15 and line 57 to column 5, line 11); (this feature is similar to the appraised values of compared subject properties. See also column 2, lines 20-24 of Hough);

Analyzing the real estate property subject to determine second objectively determinable characteristics of the real estate subject to be estimated, (column 4, line 63 to column 5, line 66);

Deriving first information representing the second objectively determinable characteristics of the real estate property to be estimated responsive to the analyzing step and

Retrieving second information representing the first objectively determinable characteristics and the objectively determinable values of the representative real estate properties (column 6, lines 5, lines 12-43 column 9, lines 5-32);

Comparing the first information received from the deriving step to the second information received from the retrieving step producing an estimated value of the real estate property portfolio when the first information of the real estate properties are statistically similar to the second information of one of the representative real estate properties (column 8, lines 34-63 and column 7, lines 43-60).

The only difference between the claimed invention and the teachings of Hough is the type of data being claimed. It is noted that the type of data does not affect the functioning of the system of Hough since in memory or computer manipulation, data is only data. The kind of data does not affect the functioning of the system. Thus, it would have been obvious to one of ordinary skill in the art to change the type of data so as to apply the principle or techniques

applied in Hough in a desired type of environment in order to determine the value of a subject property such as an intellectual property.

As per the applicant's arguments that the type of data matters and that one of ordinary skill in the art would not have turned to Hough to determine an estimated value of an intellectual property, and that Hough does not use objective characteristic of an intellectual property in determining the estimated value of a subject intellectual property. In response, the Examiner notes that similar steps claimed by the applicant are performed by Hough with the exception of the item being assessed is different.

Pakes discloses an article entitled "Patents as options: some estimates of the value of Holding European patent stocks". In the article Pakes explains the value of patent protection and parameters involved in determining the worth and value of a patent portfolio. Pakes also teaches using empirical data in determining the value of a patent portfolio. Other factors to be applied in determining the value of the intellectual properties or patents would have been the types of subject, the class of the patent, the related class/subclass of the patent or the related classes/subclasses searched by the Examiner.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the variables of an intellectual property for the variables found in a real estate property in determining the value of an intellectual property since the same functions are being applied. The motivation would have been to assess the value of an intellectual property.

As per claims 16, 29, Hough does not explicitly teach an intellectual property as indicated above. The Examiner notes that intellectual properties include patents, trademarks, trade secrets and copyrights. Substituting one of these types of data in the system of Hough would have been

obvious to one of ordinary skill in the art at the time of the invention with the motivation noted above and also to widen the scope of Hough by estimating the value of a plurality of types of properties.

As per claims 17, 30 and 44, Hough discloses using one or more databases or sources of information in estimating the value of a real estate subject. See column 4, lines 32-35 and lines 57-62 of Hough. The Examiner notes that in determining the estimated value for an intellectual property, related information regarding the related intellectual property would have been sought after. Thus, one of ordinary skill in the art would have found it obvious to look for data regarding at least one of a patent database, a trademark database, a copyright database, a technical literature database, a legal reporter database, a current events database and an intellectual property. The motivation would have been to obtain data regarding intellectual in order to make a better assessment in estimating the value of the intellectual property.

As per claims 18, 31 and 45, claims 18, 31 and 45 are directed to the various attributes found in a patent or related to a patent. Hough teaches taking into consideration various attributes such as the number of bedrooms, the neighborhood, age of the house, and other features and/or options related to a subject real estate property in determining its value. Applicant is directed to figures 12-13 and 15-16 of Hough. In assessing the value of an intellectual property it would have been obvious to one of ordinary skill in the art to use attributes or characteristics related to intellectual properties. Thus, attributes such as the number of claims, length of independent claims, number and dates of references cited, number of classes searched, legal status of the patents, number of years until each of the patents expire, group which examined each of the patents, domestic priority, and foreign

priority would have been used in order to better assess the value of an intellectual property as would have been applied in the combination of Hough and Pakes.

As per claims 19, 32, 46, claims 19, 32 and 46 also contain attributes regarding to a property. As per the limitation of the "frequency with which the patents have been cited as references for other patents", Hough discloses considering features of other real estate properties and which other kinds or similar properties were sold in estimating the value of a subject property. Applicant is directed to figures 15-16 and 18-19.

As per claims 20, 33 and 47, Hough teaches determining differences in value by weighing the values of the subject property and comparing such with the values of other properties and/or other recently sold properties.

As per claims 22, 35 and 49 Hough teaches the estimated value of the subject properties is derived substantially independent of accounting valuation techniques including cost, market and income approaches.

As per claims 23, 36 and 50, Hough teaches the first information is statistically similar to the second information of one of the representative real estate properties. See column 4, line 5 to column 7, line 60. Hough does not explicitly teach utilizing at least one of a curve fitting technique and a standard deviation technique. The Examiner asserts that a curve fitting technique or a standard deviation technique is well known in the art. Using any one of these well-known techniques would have been obvious to one of ordinary skill in the art to use in the system of Hough in order to determine a closest match between one property and the property being evaluated.

As per claims 24, 37 and 51, the objectively determinable values of the real estate properties include objectively determinable monetary values. See figures 12 and 15-18 of Hough.

As per claims 25, 38 and 52 note figures 12 and 15-18 of Hough.

As per claims 26-27, 39-40 and 53-54, note column 1, line 41 to column 2, line 49 and column 4, lines 5-49 of Hough.

Conclusion


5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Frantzy Poinvil
Primary Examiner
Art Unit 3692

FP
March 14, 2007